



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer No. 20277
	:	
Mark S. HUMAYUN, et al.	:	Confirmation No. 7732
	:	
Serial No.:10/686,775	:	Group Art Unit: 2621
	:	
Filed: October 17, 2003	:	Examiner: To Be Assigned
	:	
For:		MICROELECTRONIC STIMULATOR ARRAY FOR STIMULATING NERVE TISSUE

**DECLARATION OF KELLI N. WATSON FILED
IN SUPPORT OF PETITION UNDER 37 C.F.R. 1.47(a)**

I, Kelli N. Watson, to the best of my knowledge and belief, do hereby state as follows:

I am U.S. patent counsel to Doheny Eye Institute, assignee of the above-referenced application.

On information and belief, Mark S. Humayun ("Humayun") and James D. Weiland ("Weiland") of Doheny Eye Institute ("Doheny") and Dean Scribner ("Scribner") of the Naval Research Laboratory (the "Navy") are joint inventors of the above-captioned application ("Invention"). Scribner, however, to date has refused to sign a Declaration for the above-referenced application.

On February 5, 2004, in a telephone conference with John G. Mills, patent counsel for the Navy ("Mills"), I requested permission to contact Dean Scribner directly and/or indirectly (i.e., via sending Scribner a copy of all correspondence sent to Mills) regarding this application. Mills stated that all correspondence should be sent to and directed through Mills at the Navy. Scribner's last known residential address is 4064 North 22nd Street, Arlington, Virginia 22207.

On February 10, 2004 I sent to John G. Mills a letter enclosing a copy of the above-referenced filed application, Claim of Priority, Notice of Copied Claims, and Assignment and combined Declaration and Power of Attorney ("Declaration") for Scribner's signature. A copy of the February 10, 2004 letter is attached hereto as **Exhibit 1**. The letter including its enclosures were sent via Federal Express with a tracking number of 6523 9607 2590 to the address of the Department of the Navy, Naval Research Laboratory, 4555 Overlook Avenue, S.W., Washington, D.C. 20375-5320.

Federal Express delivered the February 10th letter on February 11, 2004 at 10:30 a.m. and receipt was signed by J. Dallas.

In the February 10, 2004 letter I requested a courtesy response to my request for execution of the Declaration and Assignment by March 10, 2004.

On March 4, 2004, I telephoned Mills seeking a response to my February 10th request that Scribner execute and return the Declaration for filing in the above-referenced application, however, I was unable to reach Mills directly and left a voicemail message regarding the same.

On March 5, 2004, I telephoned Mills seeking a response to my February 10th request that Scribner execute and return the Declaration. Mills stated that he was too busy that day to respond, but offered to look into it and get back to me on Monday, March 8, 2004.

On March 8, 2004, I telephoned Mills again seeking a response to my February 10th request that Scribner execute and return the Declaration. Mills stated he had not yet reviewed the February 10th letter and inquired as to its time sensitivity. I informed Mills that I had requested a courtesy response by March 10, 2004 in this matter.

On March 10, 2004, I sent electronic correspondence to Mills seeking a response to my February 10th request that Scribner execute and return the Declaration. A copy of the March 10th e-mail is attached hereto as **Exhibit 2**. The e-mail was sent to Mills at jgmills@ccsalph3.nrl.navy.mil and jgmills_usnavy@yahoo.com. Mills confirmed receipt of this e-mail in a telephone conversation on March 12, 2004.

On March 15, 2004 I sent electronic correspondence to Mills seeking a response as to whether or not Scribner was willing to sign and return the Declaration. A copy of the March 15th e-mail is attached hereto as **Exhibit 3**. The e-mail was sent to Mills at jgmills@ccsalph3.nrl.navy.mil and jgmills_usnavy@yahoo.com. Mills confirmed receipt of this e-mail in a follow-up telephone conversation on March 15, 2004.

On March 15, 2004 the Navy, via a facsimile signed by Mills, stated that Scribner is unwilling to sign the Declaration. A copy of the March 15, 2004 letter is attached as **Exhibit 4**.

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 10001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of any application or patent issued thereon.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Kelli N. Watson
Registration No. 47,170

Date: March 16, 2004

600 13th Street, N.W.
Washington, DC 20005-3096
Telephone: (202)756-8000
Facsimile: (202)756-8087



A Partnership Including
Professional Corporations
600 Thirteenth Street, N.W.
Washington, D.C. 20005-3096
202-756-8000
Facsimile 202-756-8087
www.mwe.com

Boston
Chicago
London
Los Angeles
Miami
Munich
New York
Orange County
Silicon Valley
Washington, D.C.

MCDERMOTT, WILL & EMERY

February 10, 2004

VIA FEDERAL EXPRESS

John G. Mills, Esq.
Department of the Navy
Naval Research Laboratory
4555 Overlook Avenue, S.W.
Washington, D.C. 20375-5320

Re: U.S. Patent Application Serial No. 10/686,775
For: MICROELECTRONIC STIMULATOR ARRAY FOR
STIMULATING NERVE TISSUE
Inventor: Mark HUMAYUN, et al.
Our Reference: 38530-017

Dear John:

As you know, we are in disagreement as to whom should be named inventors of U.S. Patent No. 6,393,327 and its division U.S. Patent Application No. 10/061,413. In order to protect Dr. Humayan's and Dr. Weiland's interest, on August 14, 2003 we filed the above-referenced application, which claims priority to U.S. Patent Application No. 10/061,413 and U.S. Patent No. 6,393,327. A copy of the application, Notice of Copied Claims and Claim of Priority are enclosed.

In order for us to proceed with prosecution, we request that Dr. Dean Scribner review the enclosed application, sign the enclosed Declaration and Power of Attorney and Assignment and return the same to me by March 10, 2004. In addition, please have Dr. Scribner print his residential address in the signature block.

We would appreciate receiving a written courtesy response to this request by March 10, 2004. In the event we do not hear from you by such date and/or Dr. Scribner refuses to sign the Declaration and Power of Attorney, we will proceed pursuant to C.F.R. § 1.47.

John G. Mills, Esq.
February 9, 2004
Page 2

We look forward to responding to any questions you may have regarding this matter.

Kind regards,

McDERMOTT, WILL & EMERY



Kelli N. Watson

KNW/dmd

Enclosures: 1. Copy of Application
 2. Copy of Claim of Priority
 3. Copy of Notice of Copied Claims
 4. Declaration
 5. Assignment

cc: Mark Humayan, M.D., Ph.D. (with Declaration and Assignment only)
 James Weiland, Ph.D. (with Declaration and Assignment only)
 Marissa Goldberg, CAO (with Declaration and Assignment only)



**DECLARATION AND POWER OF ATTORNEY
FOR APPLICATION UNDER 35 USC 111(a)**

As a below named inventor, I, Dean Scribner, hereby declare that:

My residence, post office and citizenship are as stated below next to my name,

I believe that I am, together with Mark S. Humayan and James D. Weiland, an original, first and joint inventor of the subject matter claimed and for which a patent is sought on the invention entitled MICROELECTRONIC STIMULATOR ARRAY FOR STIMULATING NERVE TISSUE, the specification of which

☐ is attached hereto

☒ was filed on October 17, 2003 as Application Serial No. 10/686,775 and was amended on January 30, 2004.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is known to me to be material to patentability in accordance with Title 37, Code of Federal Regulations, Section 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119 or Section 365 of any foreign and/or International (PCT) application(s) for patent or inventor's certificate listed below, and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Prior Foreign Applications(s):

Number	Country	Day/Month/Year filed	Priority Claimed
			<input type="checkbox"/>
			<input type="checkbox"/>

I hereby claim the benefit under 35 USC §119(e) of any United States provisional application(s) listed below.

Prior Provisional Application(s):

Application Number	Filing Date
--------------------	-------------

I hereby claim the benefit under Title 35, United States Code, Section 120 or 365 of any United States and/or International (PCT) application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, Section 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, Section 1.56 which occurred between the filing date of the prior application and the national or International (PCT) filing date of this application:

Prior U.S. Application(s):

Serial No.	Filing Date	Status: Patented, Pending, Abandoned
10/061,413	February 4, 2002	Pending
09/635,226	August 9, 2000	Patented

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

I hereby appoint the following attorney(s) and/or agent(s): Steven W. Allis, Reg. No. 50,532; Stephen A. Becker, Reg. No. 26,527; John G. Bisbikis, Reg. No. 37,095; Richard E. Brown, Reg. No. 47,453; Daniel Bucca, Reg. No. 42,368; Kenneth L. Cage, Reg. No. 26,151; Jennifer Chen, Reg. No. 42,404; Bernard P. Codd, Reg. No. 46,429; Lawrence T. Cullen, Reg. No. 44,489; Paul Devinsky, Reg. No. 28,553; Margaret M. Duncan, Reg. No. 30,879; Shamita De. Etienne-Cummings, Reg. No. 46,072; Ramyar M. Farid, Reg. No. 46,692; Brian E. Ferguson, Reg. No. 36,801; Michael E. Fogarty, Reg. No. 36,139; John R. Fuisz, Reg. No. 37,327; Keith E. George, Reg. No. 34,111; Thomas A. Haag, Reg. No. 47,621; John A. Hankins, Reg. No. 32,029; Catherine Krupka, Reg. No. 46,227; Jack Q. Lever, Reg. No. 28,149; Raphael V. Lupo, Reg. No. 28,363; Michael A. Messina, Reg. No. 33,424; Dawn L. Palmer, Reg. No. 41,238; Joseph H. Paquin, Jr., Reg. No. 31,647; Scott D. Paul, Reg. No. 42,984; William D. Pegg, Reg. No. 42,988; Robert L. Price, Reg. No. 22,685; Gene Z. Robinson, Reg. No. 33,351; Brian K. Seidleck, Reg. No. 51,321; Joy Ann G. Serauskas, Reg. No. 27,952; Jiri F. Smetana, Reg. No. 52,456; David A. Spenard, Reg. No. 37,449; Arthur J. Steiner, Reg. No. 26,106; Michael D. Switzer, Reg. No. 39,552; David M. Tennant, Reg. No. 48,362; Judith L. Toffenetti, Reg. No. 39,048; Daniel S. Trainor, Reg. No. 43,959; Shival P. Virmani, Reg. No. 45,032; Kelli N. Watson, Reg. No. 47,170; Cameron K. Weiffenbach, Reg. No. 44,488; Aaron Weisstuch, Reg. No. 41,557; Edward J. Wise, Reg. No. 34,523; Jeffrey A. Woller, Reg. No. 48,041; Alexander V. Yampolsky, Reg. No. 36,324; William Young, Reg. No. 54,718; Robert W. Zelnick, Reg. No. 36,976; and Wei-Chen Chen and Tomoki Tanida, admitted under 37 CFR 10.9(b)
all of

McDermott, Will & Emery
600 13th Street, N.W.
Washington, D. C. 20005-3096

with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith, and all future correspondence should be addressed to them.

Full name of sole or first inventor: Dean Scribner

Inventor's signature:

Date:

Residence: 4064 North 22nd Street

Citizenship: U.S.

Post Office Address: Arlington, VA 22207

Docket No.: 38530-017

ASSIGNMENT

WHEREAS I, Dean SCRIBNER, of 4064 North 22nd Street, Arlington, VA 22207, have made a certain new and useful invention together with Mark S. Humayan and James D. Weiland as set forth in an application for United States Letters Patent, entitled MICROELECTRONIC STIMULATOR ARRAY FOR STIMULATING NERVE TISSUE, for which an application for United States Letters Patent was filed on October 17, 2003, and identified by United States Serial No. 10/686,775;

AND WHEREAS, The Department of the Navy, Naval Research Laboratory, 4555 Overlook Avenue, SW, Washington, D.C. 20375-5320 is desirous of acquiring my entire right, title and interest in and to said invention and in and to any and all Letters Patent of the United States and foreign countries which may be obtained therefor;

NOW, THEREFORE, for good and valuable consideration, the receipt for and sufficiency of which is hereby acknowledged, I do hereby sell, assign, transfer and set over unto the Department of the Navy, its legal representatives, successors, and assigns, my entire right, title and interest in and to said invention as set forth in the above-mentioned application, including the right of priority and including any continuations, continuations-in-part, divisions, reissues, re-examinations or extensions thereof, and in and to any and all patents of the United States and foreign countries which may be issued for said invention;

UPON SAID CONSIDERATIONS, I hereby agree with the said assignee that I will not execute any writing or do any act whatsoever conflicting with these presents, and that I will, at any time upon request, without further or additional consideration but at the expense of said assignee, execute such additional assignments and other writings and do such additional acts as said assignee may deem necessary or desirable to perfect the assignee's enjoyment of this grant, and render all necessary assistance in making application for and obtaining original, divisional, continuations, continuations-in-part, reexamined, reissued, or extended Letters Patent of the United States or of any and all foreign countries on said invention, and in enforcing any rights or choses in action accruing as a result of such applications or patents, by giving testimony in any proceedings or transactions involving such applications or patents, and by executing preliminary statements and other affidavits, it being understood that the foregoing covenant and agreement shall bind, and inure to the benefit of the assigns and legal representatives of assignor and assignee;

Date _____	Dean Scribner _____
Date _____	_____
Date _____	_____
Date _____	_____
_____	_____

STATE OF _____)
) SS:
 COUNTY OF _____)

On this _____ day of _____, 20____, before me personally appeared Dean Scribner, to me known to be the person named in and who executed the above instrument, and acknowledged to me that he/she executed the same for the uses and purposes therein set forth.

S E A L

 Notary Public
 My Commission Expires _____

Kelli N Watson
03/10/2004 01:46 PM

To: jgmills@ccsalph3.nrl.navy.mil, jgmills_usnavy@yahoo.com
cc: mgoldberg@dohenyeyeinstitute.org, humayun@usc.edu,
jweiland@dohenyeyeinstitute.org, Eric Gordon/LA/MW&E@MW&E,
Ken Cage/DC/MW&E@MW&E
Subject: Declarations

Dear John:

Further to my February 10th correspondence and our recent telephone conversations on March 5th and 8th, I would like to follow-up with you regarding my requests for Dean Scribner's signature on:

1. The Supplementary Declaration and Assignment for U.S. Patent Application 10/640,584; and
2. The Declaration and Assignment for U.S. Patent Application 10/686,775.

Again, I kindly request a courtesy response to these requests. A Response to the Notice to File Missing Parts is due to be filed on March 16, 2004 in the '775 application. I look forward to hearing from you on or before March 13, 2004, so that we may timely prepare our response. Thank you for your attention to these matters.

Kind regards,

Kelli N. Watson
Attorney at Law
Admitted in VA DC and USPTO Only
McDermott, Will & Emery
600 Thirteenth Street, N.W.
Washington, D.C. 20005-3096
(202) 756-8351(T)
(202) 756-8087(F)
kwatson@mwe.com

This message is a PRIVATE communication. If you are not the intended recipient, please do not read, copy, or use it, and do not disclose it to others. Please notify the sender of the delivery error by replying to this message, and then delete it from your system. Thank you.

For more information on McDERMOTT, WILL & EMERY please visit our website at: <http://www.mwe.com/>

Kelli N Watson
03/15/2004 03:32 PM

To: jgmills@ccsalph3.nrl.navy.mil, jgmills_usnavy@yahoo.com
cc: Ken Cage/DC/MW&E@MW&E
Subject: Declarations

Dear John,

Further to my e-mails below and our telephone conversation on Friday, March 12, 2004, as discussed, I am looking forward to receiving your facsimile response to our original requests of February 10, 2004 that Dean Scribner execute Declarations and Assignments in the below-referenced applications. As mentioned, we have a filing deadline of **March 16, 2004** for the '775 application and would greatly appreciate your response for at least the '775 application by close of business today or soon thereafter so that we may timely respond to the USPTO.

Kind regards,

Kelli N. Watson
Attorney at Law
Admitted in VA DC and USPTO Only
McDermott, Will & Emery
600 Thirteenth Street, N.W.
Washington, D.C. 20005-3096
(202) 756-8351(T)
(202) 756-8087(F)
kwatson@mwe.com

----- Forwarded by Kelli N Watson/DC/MW&E on 03/15/2004 03:23 PM -----

Kelli N Watson
03/10/2004 01:48 PM

To: jgmills@ccsalph3.nrl.navy.mil, jgmills_usnavy@yahoo.com
cc:
Subject: Declarations

Please see my e-mail below

Kelli N. Watson
Attorney at Law
Admitted in VA DC and USPTO Only
McDermott, Will & Emery
600 Thirteenth Street, N.W.
Washington, D.C. 20005-3096
(202) 756-8351(T)
(202) 756-8087(F)
kwatson@mwe.com

----- Forwarded by Kelli N Watson/DC/MW&E on 03/10/2004 01:47 PM -----

Kelli N Watson
03/10/2004 01:46 PM

To: jgmills@ccsalph3.nrl.navy.mil, jgmills_usnavy@yahoo.com
cc: mgoldberg@dohenyeyeinstitute.org, humayun@usc.edu,
jweiland@dohenyeyeinstitute.org, Eric Gordon/LA/MW&E@MW&E,
Ken Cage/DC/MW&E@MW&E
Subject: Declarations

Dear John:

Further to my February 10th correspondence and our recent telephone conversations on March 5th and 8th, I would like to follow-up with you regarding my requests for Dean Scribner's signature on:

1. The Supplementary Declaration and Assignment for U.S. Patent Application 10/640,584; and
2. The Declaration and Assignment for U.S. Patent Application 10/686,775.

Again, I kindly request a courtesy response to these requests. A Response to the Notice to File Missing Parts is due to be filed on March 16, 2004 in the '775 application. I look forward to hearing from you on or before March 13, 2004, so that we may timely prepare our response. Thank you for your attention to these matters.

Kind regards,

Kelli N. Watson
Attorney at Law
Admitted in VA DC and USPTO Only
McDermott, Will & Emery
600 Thirteenth Street, N.W.
Washington, D.C. 20005-3096
(202) 756-8351(T)
(202) 756-8087(F)
kwatson@mwe.com

This message is a PRIVATE communication. If you are not the intended recipient, please do not read, copy, or use it, and do not disclose it to others. Please notify the sender of the delivery error by replying to this message, and then delete it from your system. Thank you.

For more information on McDERMOTT, WILL & EMERY please visit our website at: <http://www.mwe.com/>

This message is a PRIVATE communication. If you are not the intended recipient, please do not read, copy, or use it, and do not disclose it to others. Please notify the sender of the delivery error by replying to this message, and then delete it from your system. Thank you.

For more information on McDERMOTT, WILL & EMERY please visit our website at: <http://www.mwe.com/>

This message is a PRIVATE communication. If you are not the intended recipient, please do not read, copy, or use it, and do not disclose it to others. Please notify the sender of the delivery error by replying to this message, and then delete it from your system. Thank you.

For more information on McDERMOTT, WILL & EMERY please visit our website at: <http://www.mwe.com/>



DEPARTMENT OF THE NAVY
NAVAL RESEARCH LABORATORY
4555 OVERLOOK AVE SW
WASHINGTON DC 20375-5320

IN REPLY REFER TO

ORIGINAL
COPY

March 15, 2004
Ser 1008.2/0032

Ms. Kelly N. Watson
McDermott, Will, Emery
600 Thirteenth Street, N.W.
Washington, D.C. 20005-3096
202-756-7800
fax 202-756-8087

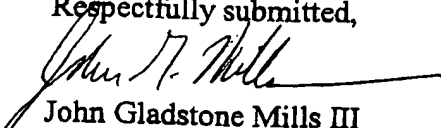
Re: U.S. Patent Application Serial No. 10/686,775
For: MICROELECTRONIC STIMULATOR ARRAY
FOR STIMULATING NERVE TISSUE
Inventor: Dr. Dean Scribner

Dear Ms. Watson:

Pursuant to your letter of February 10, 2004, accompanied with a copy of our U.S. patent application 10/061,413, we understand that you have requested that our inventor Dean Scribner sign your enclosed Declaration and Power of Attorney and Assignment. This request is made in view of prosecution of your U.S. patent application 10/686,775.

Pursuant to our earlier correspondence of August 12, 2002 and the issues raised in that letter regarding the U.S. Navy's government grants to fund this research and regarding the need for "clear and convincing evidence" of inventorship, we have reviewed your submissions and it appears that Dean Scribner is the sole inventor of the Permanent Retinal Implant Device. As your letter indicates, Dr. Scribner has received U.S. Patent 6,393,327 for this technology. In view of the documents on hand at this time, it appears that Dean Scribner solely invented this technology and thus cannot sign your Declaration and Power of Attorney and Assignment.

Respectfully submitted,


John Gladstone Mills III
Associate Patent Counsel, NRL